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EXAMINER

KENDALL, CHUCK O

ART UNIT PAPER NUMBER

2192

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/964,755

Applicant(s)

CAMPARA ET AL

Examiner

Chuck Kendall

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to the application filed 12/16/04.
2. Claims 1 – 48 have been examined.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 - 48 are rejected under 35 U.S.C. 102(b) as being anticipated by Ginter et al. USPN 5,582,900.

Regarding claim 1, a method of facilitating a technical due diligence process involving a target entity having software assets, comprising:
using a software analysis tool to extract information on the target entity's software assets (FIG. 57a, 2080 see EXTRACT and Audit); and
performing at least one subsequent step in the technical due diligence process (see 6: 30 – 55) as a function of the extracted information (FIG. 57a, 2094).

Regarding claims 2 & 25, a method as claimed in claim 1, wherein the information includes copyright information (FIG. 5B see RIGHTS, under permission, Record 808 also see 6:35 – 45).

Regarding claims 3 & 26 a method as claimed in claim 1, wherein the information includes software owner information (9:35 – 40).

Regarding claims 4 & 27, a method as claimed in claim 1, wherein the information includes third party software information (259:25 – 30).

Regarding claims 5 & 28, a method as claimed in claim 1, wherein the information includes programming language information (93:32 - 34).

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Regarding claims 6 & 29, a method as claimed in claim 1, wherein the information includes a high-level quality assessment of the software assets (192:10 – 15).

Regarding claims 7 & 30, a method as claimed in claim 1, wherein using a software analysis tool comprises:

providing software files to the software analysis tool (FIG.5B, see software, under permission content 304); and

obtaining said information from the software analysis tool (22:12 – 25).

Regarding claims 8 & 31, a method as claimed in claim 7, wherein the software files include source files (93:32 - 34).

Regarding claims 9 & 32, a method as claimed in claim 7, wherein the software files include object files (93:32 - 34).

Regarding claims 10 & 33, a method as claimed in claim 7, wherein the information includes a list of entities having copyright in at least one of the software files (for list see FIG.5B, 808, for RIGHTS and Permissions records).

Regarding claims 11 & 34, a method as claimed in claim 7, wherein the information includes a list of entities and the proportion of the software files in which each of said entities has copyright (17:18 – 40).

Regarding claims 12 & 35, a method as claimed in claim 7, wherein the information includes the proportion of the software files in which no entity has copyright.

Regarding claims 13 & 36, a method as claimed in claim 7, wherein the information includes the proportion of the software files in which at least one entity has copyright (45:3 – 15, see rights defined for eligible parties, examiner believes there's atleast one party defined as ineligible as interpreted).

Regarding claims 14 & 37, a method as claimed in claim 7, wherein the information includes a list of creators having created at least one of the software files (FIG.2A, see content creator, 102).

Regarding claims 15 & 38, a method as claimed in claim 7, wherein the information includes a list of creators and the proportion of the software files created by each of said creators (FIG.2A, see content creator, 102, and 112).

Regarding claims 16 & 39, a method as claimed in claim 7, wherein the information includes the proportion of the software files not specified as being created by any creator (FIG.80).

Regarding claims 17 & 40, a method as claimed in claim 7, wherein the information includes the proportion of the software files specified as being created by at least one Creator (FIG. 80 and 81, Creator A and B).

Regarding claims 18 & 41, a method as claimed in claim 7, wherein the information includes a list of third party software vendors whose products are needed by at least one of the software files (FIG. 12, 730, and associated text, see 108:30 – 35, for third party database vendors).

Regarding claims 19 & 42, a method as claimed in claim 7, wherein the information includes a list of third party software vendors whose operating systems are needed by at least one of the software files (108:30 – 35, for third party database vendors).

Regarding claims 20 & 43, a method as claimed in claim 7, wherein the information includes a list of third party software vendors whose software tools are needed by at least one of the software files (108:30 – 35).

Regarding claims 21 & 44, a method as claimed in claim 7, wherein the information includes a list of programming languages and the proportion of the software files programmed in each of said programming languages (FIG. 74, see software description list database)

Regarding claims 22 & 45, a method as claimed in claim 7, wherein the information includes a list of file formats and the proportion of the software files in each of said file Formats (FIGs,17, 18 and 22 show different formats).

Regarding claims 23 a method as claimed in claim 7, wherein using a software analysis tool further comprises:

running the software analysis tool on the software files (FIG. 67B, 3350).

Regarding claim 24, a method as claimed in claim 46, wherein the third party using a software analysis tool to extract information on the target entity's software asset comprises:

providing software files to the software analysis tool; and the third party obtaining said information on the target entity's software assets from the software analysis tool (6: 30 – 55, shows different third parties i.e., financial service providers, content providers).

Regarding claim 46, a method of facilitating a transaction involving an expanding entity and a target entity having software assets, comprising:

a third party using a software analysis tool to extract information on the target entity's software assets (259:25 – 30); the third party providing the extracted information to the expanding entity (259:25 – 30); and

the expanding entity performing at least one subsequent step in the transaction as a function of the information provided by the third party (259:25 – 30).

Regarding claim 47, a method as claimed in claim 46, wherein the third party is contracted by the expanding entity (259:25 – 30, see commercial party).

Regarding claim 48, a method as claimed in claim 46, wherein the third party is contracted by the target entity (259:25 – 30, see third party information collection point).

Response to Arguments

5. Applicant's arguments filed 12/16/2004 have been fully considered but they are not persuasive.

In Applicants amendment of 12/16/04 on page 10 of 13, with regards to claims 1 – 48, Applicant asserts that Ginter does not disclose a technical due diligence process. Applicant specifies this due diligence process to encompass corporate transactions such as a merger, acquisition, investment, etc.

Responding, to Applicant's argument in claims, Examiner would like to point out that Applicants claims, claim rather broadly a due diligence process. Due diligence processes have been in the information systems art for years and one would interpret a diligence process or decision support system to be the inherent nature of any enterprise or framework system which is able to decision or manage and process technical information. That is the sole purpose of an information system to be able to make decision using gathered data. Notwithstanding Ginter, does however teach in 6: 30 – 55, a VDE secure system “ for regulating electronic conduct and commerce”, stating further that, “Regulation is ensured by control information put in place by one or more parties. These parties may include content providers, financial service providers, or electronic “infrastructure” companies...”. As taught by Ginter and as understood by Examiner regulating using control information, is equivalent to decisioning. However, Ginter also teaches in 16: 66 – 17:5, “programming language tools that support merging of control and auditing capabilities in nearly any electronic appliance environment...”. This is consistent with Applicant's definition of a technical due diligence support system as described in Applicant's argument on page 10, 2nd paragraph of his response.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chuck Kendall whose telephone number is 571-272-3698. The examiner can normally be reached on 10:00 am - 6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam can be reached on 571-272-3695. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Resonance Ch.

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